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09/987,017	11/13/2001	Toshiyuki Sakurai	011441	6353

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EXAMINER

AVELLINO, JOSEPH E

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/987,017

Applicant(s)

SAKURAI ET AL.

Examiner

Joseph E. Avellino

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-15 are presented for examination; claims 1, 6, 8, 9, 12, 13, and 15 independent.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the sixth paragraph of 35 U.S.C. 112:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

3. Claims 1-15 are rejected under 35 U.S.C. 112, sixth paragraph as being a means plus function claim without proper support in the disclosure. See MPEP 2181. To overcome this rejection, Applicant must:

- Invoke the right under 35 U.S.C., sixth paragraph to have these claims be treated as means plus function claims. See *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994), and
- Identify the corresponding structure, material or acts in the written description necessary to perform that function. See *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1381, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999).

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Berman et al. (USPN 5,995,939) (hereinafter Berman).

5. Referring to claim 1, Berman discloses a linkage system which links a first computer of a first medical institution with a second computer of a second medical institution through a network (Figure 1, ref. 30-42),

wherein the first computer of the first medical institution comprising:

a communication terminal (i.e. client system 10) for sending out an email to the network and receiving an email from the network (col. 5, lines 31-62);

an inquiry file creating means for creating an inquiry basic data file having a patient information and inquiry contents (col. 5, lines 38-55);

an inquiry mail creating means for creating an email having the inquiry basic data file as an attachment file thereto (the Office takes the term "attachment" as "connected in some form") and addressing to the second computer (col. 5, line 54 to col. 6, line 39);

a reply contents output means for outputting reply contents being included in an attachment file of a received email in a predetermined mode (col. 6, line 45-52; col. 9, lines 9-42); and

wherein the second computer of the second medical institution comprising:

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a communication terminal for sending out an email to the network and receiving an email from the network (col. 7, lines 50-62);

an inquiry contents output means for outputting inquiry contents being included in an attachment file of a received email in a predetermined mode (Figure 5; col. 8, lines 27-46);

a reply file creating means for creating a reply basic data file having an answer to the outputted inquiry contents (Figure 5; col. 8, line 47-57); and

a reply mail creating means for creating an email having the reply basic data file as an attachment file thereto and addressing to the first computer (e.g. abstract; col. 8, lines 20-53).

6. Referring to claim 2, Berman discloses the inquiry file creating means further creating a medical data file based on a medical data of the patient specified by the patient information (col. 5, lines 38-57); and

wherein the inquiry mail creating means creating the email further having the medical data file as an attachment file thereto (col. 5, lines 38-67).

7. Referring to claim 3, Berman discloses the second computer comprising a data extracting means for extracting medical data from the medical data file being attached to the received email (col. 5, line 63 to col. 6, line 19);

and wherein the reply file creating means further creating a reply attached data file based on the extracted medical data (e.g. abstract; col. 8, lines 33-46);

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and wherein the reply mail creating means creating the email further having the reply attached data file as the attachment file thereto (col. 8, lines 33-46).

8. Referring to claim 4, Berman discloses the second computer comprising a data editing means for editing the extracted medical data (i.e. database updating) (col. 7, lines 23-36); and

Wherein the reply file created means creating the reply attached data file based on the edited medical data (col. 7, lines 23-36)

9. Referring to claim 5, Berman discloses a patient data item selecting means for designating each patient data item to be given to the inquiry file creating means as the patient information (col. 5, lines 38-57); and

a patient data item revising means for revising the contents of the designated patient data item (i.e. database update) (col. 7, lines 45-50).

10. Claims 6-15 are rejected for similar reasons as stated above.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Berman, et al. (WO 98/1683) (hereinafter PCT).

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11. Referring to claim 1, PCT discloses a linkage system which links a first computer of a first medical institution with a second computer of a second medical institution through a network (Figure 1, ref. 30-42),

wherein the first computer of the first medical institution comprising:

a communication terminal (i.e. client system 10) for sending out an email to the network and receiving an email from the network (p. 9, line 32 to p. 10, line 31);

an inquiry file creating means for creating an inquiry basic data file having a patient information and inquiry contents (p. 10, lines 4-25);

an inquiry mail creating means for creating an email having the inquiry basic data file as an attachment file thereto (the Office takes the term "attachment" as "connected in some form") and addressing to the second computer (p. 10, line 26 to p. 12, line 9);

a reply contents output means for outputting reply contents being included in an attachment file of a received email in a predetermined mode (p. 12, lines 16-23; p. 17, line 14 to p. 20, line 18); and

wherein the second computer of the second medical institution comprising:

a communication terminal for sending out an email to the network and receiving an email from the network (p. 14, lines 22-34);

an inquiry contents output means for outputting inquiry contents being included in an attachment file of a received email in a predetermined mode (Figure 5; p. 15, line 33 to p. 16, line 16);

a reply file creating means for creating a reply basic data file having an answer to the outputted inquiry contents (Figure 5; p. 16, lines 17-27); and

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a reply mail creating means for creating an email having the reply basic data file as an attachment file thereto and addressing to the first computer (e.g. abstract; p. 15, line 25 to p. 16, line 28).

12. Referring to claim 2, PCT discloses the inquiry file creating means further creating a medical data file based on a medical data of the patient specified by the patient information (p. 9, line 32 to p. 10, line 25); and

wherein the inquiry mail creating means creating the email further having the medical data file as an attachment file thereto (p. 10, line 4 to p. 11, line 23).

13. Referring to claim 3, PCT discloses the second computer comprising a data extracting means for extracting medical data from the medical data file being attached to the received email (p. 10, line 32 to p. 11, line 23);

and wherein the reply file creating means further creating a reply attached data file based on the extracted medical data (e.g. abstract; p. 16, lines 4-16);

and wherein the reply mail creating means creating the email further having the reply attached data file as the attachment file thereto (p. 16, lines 4-16).

14. Referring to claim 4, PCT discloses the second computer comprising a data editing means for editing the extracted medical data (i.e. database updating) (p. 13, line 28 to p. 14, line 6); and

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wherein the reply file created means creating the reply attached data file based on the edited medical data (p. 13, line 28 to p. 14, line 6).

15. Referring to claim 5, PCT discloses a patient data item selecting means for designating each patient data item to be given to the inquiry file creating means as the patient information (p. 14, lines 7-34); and

a patient data item revising means for revising the contents of the designated patient data item (i.e. database update) (p. 14, lines 16-22).

16. Claims 6-15 are rejected for similar reasons as stated above.

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Killcommons et al. (USPN 6,424,996) (hereinafter Killcommons) in view of Berman.

19. Referring to claim 1, Killcommons discloses a linkage system which links a first computer of a first medical institution (i.e. a client device) with a second computer (i.e. a medical image server) of a second medical institution through a network,

wherein the first computer of the first medical institution comprises:

a communication terminal for sending out browser requests to the network and receiving an email from the network (e.g. abstract);

a browser request creating means for creating a data file having a patient information and inquiry contents (col. 12, lines 51-61);

a reply contents output means for outputting reply contents being included in an attachment file (i.e. email package) of a received email in a predetermined mode (Figure 4); and

wherein the second computer of the second medical institution comprising:

a communication terminal for sending out an email to the network and receiving an enhanced browser request from the network (e.g. abstract; Figures 3-4; col. 12, lines 4-61);

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an inquiry contents output means for outputting inquiry contents being included in an attachment of a received enhanced browser request in a predetermined mode (col.

12, lines 33-62);

a reply file creating means for creating a reply basic data file (i.e. email package) having an answer to the outputted inquiry contents (col. 12, lines 51-62); and

a reply mail creating means for creating an email having the reply basic data file as an attachment file thereto and addressing to the first computer (e.g. abstract; col. 9, lines 12-21).

Killcommons does not specifically state that the first computer of a first medical institution can send out an email, however Killcommons does state that the user unit 50 includes a platform such as a Personal Computer (PC) such as the Windows based PC, which is well known in the art to support sending emails through a network.

Killcommons also does not disclose creating an inquiry mail creating means for creating an email having the inquiry basic data file as an attachment file thereto and addressing to the second computer. In analogous art, Berman discloses another linkage system which links a first computer of a first medical institution with a second computer of a second medical institution through a network which includes an inquiry mail creating means for creating an email having the inquiry basic data file as an attachment file thereto and addressing to the second computer (col. 5, line 54 to col. 6, line 39). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Berman with Killcommons since Killcommons discloses the embodiments provide executing steps by a browser or otherwise to

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produce the invention as described at col. 4, line 54 to col. 5, line 5. This would lead one of ordinary skill in the art to search other methods of requesting data from a server, eventually discovering the system as described in Berman by converting a service request into an appropriate email format and then send the email to an outgoing client mailbox for processing as described in Berman (Figure 2, ref. 112, 116; col. 5, lines 35-38, 57-62).

20. Referring to claim 2, Killcommons discloses the invention substantively as described in claim 1. Killcommons does not disclose the inquiry file creating means further creating a medical data file based on a medical data of the patient specified by the patient information and creating the email further having the medical data file as an attachment file thereto. In analogous art, Berman discloses another linkage system which links a first computer of a first medical institution with a second computer of a second medical institution through a network wherein the inquiry file creating means further creating a medical data file based on a medical data of the patient specified by the patient information (col. 5, lines 38-57); and wherein the inquiry mail creating means creating the email further having the medical data file as an attachment file thereto (col. 5, lines 38-67). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Berman with Killcommons since Killcommons discloses the embodiments provide executing steps by a browser or otherwise to produce the invention as described at col. 4, line 54 to col. 5, line 5. This would lead one of ordinary skill in the art to search other methods of requesting data

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from a server, eventually discovering the system as described in Berman by converting a service request into an appropriate email format and then send the email to an outgoing client mailbox for processing as described in Berman (Figure 2, ref. 112, 116; col. 5, lines 35-38, 57-62.

21. Referring to claim 3, Killcommons discloses the invention substantively as described in claim 1. Killcommons does not disclose the second computer extracting medical data from the medical data file being attached to the received email, and wherein the reply file creating means further creating a reply attached data file based on the extracted medical data, and wherein the reply mail creating means creating the email further having the reply attached data file as the attachment file thereto. In analogous art, Berman discloses another linkage system which links a first computer of a first medical institution with a second computer of a second medical institution through a network wherein the second computer comprising a data extracting means for extracting medical data from the medical data file being attached to the received email (col. 5, line 63 to col. 6, line 19); and wherein the reply file creating means further creating a reply attached data file based on the extracted medical data (e.g. abstract; col. 8, lines 33-46); and wherein the reply mail creating means creating the email further having the reply attached data file as the attachment file thereto (col. 8, lines 33-46). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Berman with Killcommons since Killcommons discloses the embodiments provide executing steps by a browser or otherwise to

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produce the invention as described at col. 4, line 54 to col. 5, line 5. This would lead one of ordinary skill in the art to search other methods of requesting data from a server, eventually discovering the system as described in Berman by converting a service request into an appropriate email format and then send the email to an outgoing client mailbox for processing as described in Berman (Figure 2, ref. 112, 116; col. 5, lines 35-38, 57-62).

22. Referring to claim 4, Killcommons discloses the invention substantively as described in claim 1. Killcommons does not specifically disclose the second computer editing the extracted medical data, and the reply file creating the reply attached data file based on the edited medical data. In analogous art, Berman discloses another linkage system which links a first computer of a first medical institution with a second computer of a second medical institution through a network wherein the second computer comprising a data editing means for editing the extracted medical data (i.e. database updating) (p. 13, line 28 to p. 14, line 6); and wherein the reply file created means creating the reply attached data file based on the edited medical data (p. 13, line 28 to p. 14, line 6). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Berman with Killcommons since Killcommons discloses the embodiments provide executing steps by a browser or otherwise to produce the invention as described at col. 4, line 54 to col. 5, line 5. This would lead one of ordinary skill in the art to search other methods of requesting data from a server, eventually discovering the system as described in Berman by converting

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a service request into an appropriate email format and then send the email to an outgoing client mailbox for processing as described in Berman (Figure 2, ref. 112, 116; col. 5, lines 35-38, 57-62).

23. Referring to claim 5, Killcommons discloses the invention substantively as described in claim 1. Killcommons does not specifically disclose designating each patient data item to be given to the inquiry file creating means as the patient information, and revising the contents of the designated patient data item. In analogous art, Berman discloses another linkage system which links a first computer of a first medical institution with a second computer of a second medical institution through a network wherein a patient data item selecting means for designating each patient data item to be given to the inquiry file creating means as the patient information (col. 5, lines 38-57); and a patient data item revising means for revising the contents of the designated patient data item (i.e. database update) (col. 7, lines 45-50). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Berman with Killcommons since Killcommons discloses the embodiments provide executing steps by a browser or otherwise to produce the invention as described at col. 4, line 54 to col. 5, line 5. This would lead one of ordinary skill in the art to search other methods of requesting data from a server, eventually discovering the system as described in Berman by converting a service request into an appropriate email format and then send the email to an outgoing client mailbox for processing as described in Berman (Figure 2, ref. 112, 116; col. 5, lines 35-38, 57-62).

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24. Claims 6-15 are rejected for similar reasons as stated above.

### ***Conclusion***

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

26. Prust (USPN 6,735,623) discloses accessing a remote storage area.

27. Shewmake et al. (US 2003/0208108) discloses cardiovascular healthcare management.

28. Muraca (US 2002/0055917) discloses using a master control file for computer software interoperability between disparate OS.

29. Saito et al. (US 20022/0026329) discloses health care information system.

30. Kimata (US 2001/0034617) discloses sharing information concerning medical treatment of an individual.

31. Rothschild et al. (USPN 6,678,703) discloses medical image management system and method.

32. Shavit (USPN 4,799,156) discloses interactive market management system.

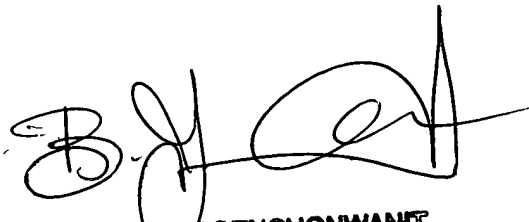
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEA  
November 15, 2004



**BUNJOR JAROENCHONWANT**  
**PRIMARY EXAMINER**